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REMARKS

NOV 17 2006

Pending Claims

Assuming entry of this response, claims 1 and 3-6 are still pending, without change relative to the previous amendment. The applicants' are not requesting any amendments to the most recently presented claims, that is, the claims submitted on 5 May 2006 in response to the 8 February 2006 Office action.

Telephone Discussion

I thank Examiner Sheikh, and his supervisor Ryan Zeender, for their prompt reply on 26 October to my request to discuss the unusually complicated and unnecessarily drawn-out prosecution of this application to date. (See below for a summary "for the record.")

Claim Rejections

All of the pending claims stand rejected under 35 USC 103(a) because of alleged obviousness in view of a proposed combination of US 6,088,677 (*Spurgeon*) and US 5,991,742 (*Tran*). In essence, the Examiner wrote that *Spurgeon* teaches all of the elements of the applicants' remaining independent claim except for having time as the information to be reported, but that *Tran* teaches time reporting.

Spurgeon is concerned with providing a system "for controlling the exchange of business and clinical information between an insurer and multiple health care providers" (abstract), in particular, "within [an] existing environment of disparate hardware and software" (col. 3, lines 13-14) and where "differing operating systems and database structures within the applications prevent the direct transfer of information therebetween" (col. 2, lines 49-51).

Spurgeon lacks advantageous claimed features of the applicants' invention, by deliberate design. For example, claim 1 of this application recites (emphasis added):

- "automatically, that is, independent of any required human intervention: i) receiving over a transmission channel an ***electronic representation of an image of a physical form*** that embodies a report
..."

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Thus, the applicants' invention is designed to operate automatically upon receipt of an image such as one created by a fax machine. This enables users to submit information without having to enter it into particular computers loaded with specialized software such as the "provider interface portion" and "client application" *Spurgeon* requires.

Spurgeon is specifically *not* intended to operate with images of physical forms, that is, with initial input devices such as fax machines or scanners. See for example,

Col. 4, lines 2-8 (emphasis added):

The provider interface portion then transmits the claim up to the web server and there it is translated, reformatted and transmitted via push technology to the insurer's HIS or to a third party claim processor. This automatic exchange *replaces the prior system of the providers' printing out the claims and mailing or faxing the printed claims* to the insurer for manual reentry.

and

Col. 4, lines 55-61 (emphasis added):

A main advantage of the information-exchange system is the increased speed with which claims are processed and paid and with which a subscriber may learn if a requested treatment will be paid for by the insurer. *The replacement of fax, telephone and mail with a high-speed, computerized system as a continuous conduit for all aspects of these requests produces the increased speed.*

Note that *Spurgeon* fails to realize that use of fax input does not necessarily require manual reentry in later processing steps. Moreover, filling in a common form will seldom take much more time – and often less – than having to enter data using an on-screen display, especially if one takes into account the need for *Spurgeon*'s subscribers or providers to actually locate themselves at a properly configured provider computer. In other words, *Spurgeon* fails to realize that the applicants' invention is possible – as claimed, the applicants' invention enables:

- "automatically ... , that is, independent of any required human intervention: ... ii) identifying the location of the data fields in the received representation of the image of the form; and iii) both extracting report data from the report and storing the extracted report data in a predetermined common format in a memory for subsequent processing"

In short, disproving *Spurgeon*, the applicants' invention allows for submission of faxed forms without requiring any manual reentry at all, with much greater universality (no need to be at special computers), and with at most negligible sacrifice of speed.

The applicants' invention also provides for (emphasis added):

- "automatically, that is, independent of any required human intervention, completing any requests for ***interactive and iterative review, modification or annotation***, inclusive, of the report data by the agency and client according to each party's respective party-specific rules"

Except for initial data entry, *Spurgeon* has no notion of any mechanism by which parties can access the contents of an insurance claim as stored in *Spurgeon's* main information-exchange computer 12 (the central, controlling system) and then interactively and iteratively review, modify or annotate a submitted insurance claim; rather, since *Spurgeon* relies solely on push technology, it is essentially "top down," with the central system pushing information as needed to other systems. Note that the correction of errors described in col. 9, lines 21-25 (emphasis added) is *not* for errors in submitted claim forms, but rather only in a patient's "demographic" data in the local provider's database:

if the subscriber discovers at the provider office that some subscriber demographics in the provider database are incorrect either because of a data entry error at the insurer or change to the subscriber's circumstances, ***changes to the database may be made to the provider database.***

In other words, an actual submitted claim is not annotated modified, annotated, but rather only locally stored information about a particular subscriber (patient), which is corrected locally before the insurance claim is submitted to the central system. The advantages of the applicants' interactive and iterative review, modification and annotation have been explained in earlier responses to Office actions, and are therefore not repeated here.

Claim 1 thus recites features of the applicants' invention that are not found in *Spurgeon* – indeed, that *Spurgeon* explicitly does not want –, that provide technical advantages of flexibility and universality without sacrificing accuracy or processing speed, and that are also not found in *Tran*. The applicants therefore respectfully submit that claim 1, and the remaining dependent claims, are allowable not only over all the

prior art cited by previous examiners (as the immediately preceding examiner also felt), but also over the newly discovered and cited *Spurgeon* reference, whether viewed in isolation or in combination with *Tran* or any other reference of record.

Prosecution History to Date

The applicants have been put through a proverbial patent wringer, through no fault of their own:

13 May 2003 – first Office action, by Examiner Christopher Buchanan, rejecting all claims under §103 in view of Swart alone.

28 November 2003 – second Office action, also by Examiner Buchanan, maintaining the Swart rejection. The applicants respond, along with a Request for Continued Examination (RCE).

At this point, although the applicants disagreed with the applicability of Swart, at least the prosecution was proceeding "normally." Then came:

18 August 2004 – third Office action, by Examiner Andrew Fischer, in which, among other things, he discovered for the first time a need to require restriction of the claims and found the never-amended drawings objectionable. He also started a very time-consuming and in many parts incomprehensible line of rejection based on "lexicography," although Examiner Buchanan apparently did not think that the applicants' standard use of common terms, which were even defined in the specification, required Examiner Fischer's extensive exegesis.

11 May 2005 – fourth Office action, also by Examiner Fischer, in which he – for the first time – rejected claims based on a newly found reference *Kahn*, which also could just as well have been found the first three times around. The applicants had to file another RCE, and of course pay a third time.

8 February 2006 – *fifth* Office action, in which Examiner Fischer rejected every claim but claim 12 under §103 as being unpatentable over assorted *newly cited* prior art that was available for him and the previous examiner to cite in any of the four previous Office actions. Examiner Fischer did indicate, however, that claim 12 would be allowable if rewritten in independent form. Worn down by time and expense, and the need to obtain some useful protection for the product they are attempting to market, the

applicants did as the Examiner indicated and narrowed their application to an independent version of claim 12, plus some previously submitted dependent claims.

18 September 2006 – This *sixth* Office action, by the *third* examiner, all but starting the whole process from the beginning again by rejecting even the previously allowable claim based on completely new prior art that was available to be cited in any of the previous five Office actions by either of the previous two examiners.

The applicants fully understand that what happened in the past is in no way the responsibility of newly assigned Examiner Sheikh, and I as their attorney appreciate the time he and (temporary) supervisor Zeender gave me to discuss this case a few weeks ago. Moreover, the applicants appreciate that Examiner Sheikh is just trying to do his job properly. Nonetheless, just for the record the applicants wish to point out:

MPEP - 707.07(g) Piecemeal Examination

Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references.

and

MPEP - 706.04 Rejection of Previously Allowed Claims

A claim noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the primary examiner for consideration of all the facts and approval of the proposed action. Great care should be exercised in authorizing such a rejection. See Ex parte Grler, 1923 C.D. 27, 309 O.G. 223 (Comm'r Pat. 1923); Ex parte Hay, 1909 C.D. 18, 139 O.G. 197 (Comm'r Pat. 1909).

PREVIOUS ACTION BY DIFFERENT EXAMINER

Full faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general, an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner, or make a new search in the mere hope of finding something. Amgen, Inc. v. Hoechst Marion Roussel, Inc., 126 F. Supp. 2d 69, 139, 57 USPQ2d 1449, 1499-50 (D. Mass. 2001).

In this case, the examination process has been very clearly piecemeal. Moreover, Examiner Sheikh withdrew the allowability of claim 12 in view of the "***newly discovered*** reference(s) to *Spurgeon* ..." (emphasis added), that is, a "new search," which, unless he asserts Examiner Fischer made a "clear error" in his allowance, was presumably in the hope of finding another reference.

The point of this discussion is not to assign "blame," especially not to Examiner Sheikh, who's just being diligent, but rather to illustrate that the applicants' actions – in particular, narrowing and cancellation of claims – have been necessary just to try to make reasonable progress toward allowance of some meaningful claims in a situation where the "finish line" of allowance has been repeatedly moved away from them. The applicants have narrowed and cancelled claims in a good-faith effort to advance prosecution before their resources and market opportunities run out, not because they concede that the previous rejections based on prior art were well-founded. Accordingly, the applicants emphasize what they previously wrote:

"To move this application to allowance, the applicants have cancelled all but [one independent] claim that the Examiner [Fischer] indicated as being allowable. The applicants wish to note for the record, however, that the arguments they and an expert in the field have made explain why even the broader claims should be allowed. They therefore wish to reserve the right to obtain the broader coverage they deserve in a continuing application."

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Conclusion

The applicants have shown why *Spurgeon* no more anticipates the invention or renders it obvious than did the previously cited prior art, whether considered alone or in combination with any other cited reference. Claim 1 and the dependent claims should therefore still be allowable.

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Respectfully submitted,



34825 Sultan-Startup Rd.
Sultan, WA 98294
Phone & fax: (360) 793-6687

Jeffrey Pearce
Reg. No. 34,729
Attorney for the Applicant(s)